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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/541,063

06/29/2005

Koji Utsugi

8017-1172

3808

466 7590 12/11/2008
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EXAMINER

ENIN-OKUT, EDU E

ART UNIT

PAPER NUMBER

1795

MAIL DATE

DELIVERY MODE

12/11/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/541,063	Applicant(s) UTSUGI ET AL.	
	Examiner Edu E. Enin-Okut	Art Unit 1795	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) 1-12 and 14-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 June 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/29/05</u> . | 6) <input type="checkbox"/> Other: _____ |

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**ELECTROLYTE SOLUTION FOR SECONDARY BATTERY AND SECONDARY BATTERY
USING SAME**

Election/Restrictions

1. Applicant's election without traverse of Group III (claim 13) in the reply filed on October 1, 2008 is acknowledged.

2. Claims 1-12 and 14-16 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected inventions, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on October 1, 2008.

Priority

3. Acknowledgment is made of applicant's claim for foreign priority based on Japanese Patent Application No. 2003-416516 and 2004-317301, filed on December 15, 2003 and October 29, 2004, respectively. It is noted, however, that applicant has not filed a certified copy of the above-described applications as required by 35 U.S.C. 119(b).

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

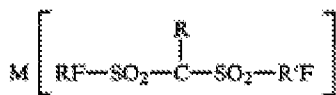
A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claim 13 is rejected under 35 U.S.C. 102(b) as being anticipated by Armand (US 4,818,644).

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Regarding claim 13, Armand teaches an ionically conductive material composed of a salt represented by one of the following formulas in a liquid or solid solvent with applications to electrochemistry (Abstract, 1:7-51):



in which M is an alkali metal, alkaline earth metal, transition metal, or rare earth; RF and R'F, which are the same or different, each represents a perhalogenated, preferably perfluorinated group, having from 1 to 12 carbon atoms; and, R is hydrogen or an alkyl group having from 1 to 30 carbon atoms.

Armand teaches that the salt in solution in a liquid or solid solvent (e.g., aprotic solvents such as linear ethers such as diethyl ether, dimethoxyethane, or cyclic ethers such as tetrahydrofuran, dioxane, or dimethyltetrahydrofuran; esters such as methyl or ethyl formate, propylene or ethylene carbonate, or the butyrolactones; nitriles, acetonitriles, benzonitriles; nitrated derivatives such as nitromethane or nitrobenzene; amides such as dimethylformamide, diethylformamide, or N-methylpyrrolidone; and, sulfones such as dimethyl sulfone, tetramethylene sulfone, and other sulfolanes; and, polymers such as homopolymers or copolymers of ethylene oxide; polyphosphazenes; or imides) can be used as a liquid or solid electrolyte in an electrochemical generator, such as primary or secondary batteries (1:4-6, 1:52-67, 2:38-46). The salts have a high solubility in the solvents described above (1:67-68). The ionically conductive material includes the salt pursuant to one of the formula above, but it can also include a second salt or several other salts, provided that all of these salts have the same cation (2:9-13).

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would

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have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claim 13 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 12 of copending Application No. 10/582,855. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant application claims an electrolyte additive. The disclosure of the instant application differs from Application No. 10/582,855 in that the instant application does not teach the use of the additive in a secondary battery. However, it would have been obvious to one of ordinary skill in the art at the time of the invention to use the additive in a lithium secondary battery to improve its capacity retention ratio and suppress an increase of resistance during storage (see instant application disclosure, para. 32).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Correspondence / Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Edu E. Enin-Okut** whose telephone number is **571-270-3075**. The examiner can normally be reached on Monday - Thursday, 7 a.m. - 3 p.m.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dah-Wei Yuan can be reached on 571-272-1295. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Edu E Enin-Okut/
Examiner, Art Unit 1795

/Dah-Wei D. Yuan/
Supervisory Patent Examiner, Art Unit 1795